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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,465	08/20/2003	Henry Marshall Israel	2550-001	5945

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3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/644,465

Applicant(s)

ISRAEL ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-72 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42, 44-49 and 51-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/22/04, 3/9/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>APPENDIX A AND B</u> |

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Applicant's election with traverse of the species of figures 7 and 8 in the reply filed on Nov. 6, 2006 is acknowledged. The traversal is on the ground(s) that the non-elected embodiments do not require undue diverse searching because the subject matter is within the same class. This is not found persuasive because the non-elected embodiments are significantly different in structure as compared to the elected embodiment and therefore require searching in different subclasses.

The requirement is still deemed proper and is therefore made FINAL.

Claims 43 and 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Nov. 6, 2006.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 51-56 and 66-72 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. The scope of claim 49 is unclear. Specifically, the preamble indicates that a flexible connector is claimed while the adjacent vertical meander patterns are part of the environment in which the flexible connector is intended to be used are thus are not claimed (noting the phrase "for connecting loops of adjacent vertical meander patterns" in lines 1-2). However, the body of claim implies that the adjacent vertical meander patterns are part of the claimed combination (noting the phrase "points of attachment of the member to the adjacent vertical meander patterns" in lines 4-5 which implies that the adjacent vertical meander patterns are attached to the member and thus are part of the claimed combination). As to claims 52 and 66, the ordinary meaning of "even" and "odd" (when these words are used together) is that even" refers to a number that is divisible by two while odd refers to a number that is not divisible by two. However, this meaning is inconsistent with the claims. It is not clear what applicant intends to mean by these terms. Further, claim 66, paragraph g. is confusing and inaccurate since there are many loops (much more than two) of the first meander patterns between each pair of second meander patterns along the entire length of the stent.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42, 44-49, 51, 57-60, 63-69 and 72 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pinchasik et al. (5,449,373). As to claim 42, Pinchasik et al., in figures 3A-3C, disclose a plurality of continuous serpentine sections (as shown in the attached appendix A), a plurality of flexible connectors 124 forming a generally uniformly sized cell structure (as shown in appendix A), each of the connectors being

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elongatable in a bend of a lumen to maintain a generally uniformly sized cell structure in the bend after expansion (the above identified cells will inherently still be generally uniformly sized in the bend since any difference between the cell sizes will be relatively small, particularly in a small bend. Alternatively, it would have been obvious that the cells will still be generally uniformly sized in the bend when the bend is small since any effect the bend would have on the cell size would be small due to the smallness of the bend. As to claim 46, the top end of the Pinchasik et al. connectors are open, closed, open and closed along the longitudinal axis of the stent from the left to the right as seen in figures 3A-3C. As to claim 57, Pinchasik et al., in figures 3A-3C, disclose first meander patterns and second meander patterns as shown in the attached appendixes A and B.

Claims 52-56, 61, 62, 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchasik et al. (5,449,373). As to claims 52-56, Pinchasik et al. fail to disclose the loops 128 of the second meander pattern as having a smaller width (claim 52) or being more flexible than the loops of the first meander pattern (claim 56). However, it is old and well known in this art to reduce the width of a hinged area of a stent where bending is desired in order to obtain the advantage

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of facilitating such bending. It would have been obvious to reduce the width of the hinged area (loops 128) of the Pinchasik et al. stent so that it too would have this advantage. As to claims 61, 62, 70 and 71, Pinchasik et al. fail to disclose medicine on the stent. However, it is old and well known in this art to include medicine coatings on stents in order to obtain the advantage of facilitating the directing of the medicine directly to the target site. It would have been obvious to include a medicine coatings on the Pinchasik et al. stent so that it too would have this advantage.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42, 44-49 and 51-72 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,635,084, claims 1-83 of U.S. Patent No. 6,461,381, claims 1-64 of U.S. Patent No. 5,972,018, claims 1-29 of U.S. Patent No. 5,843,120, claims 1-31 of U.S. Patent No. 5,733,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because the slight difference in the wording of the claims involves an obvious difference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

mht

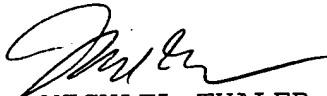

MICHAEL THALER
PRIMARY EXAMINER
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FIG. 3A

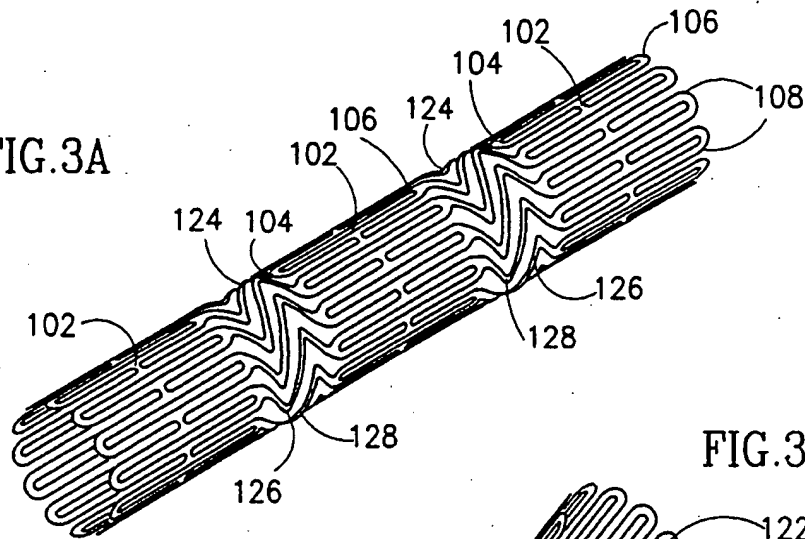


FIG. 3B

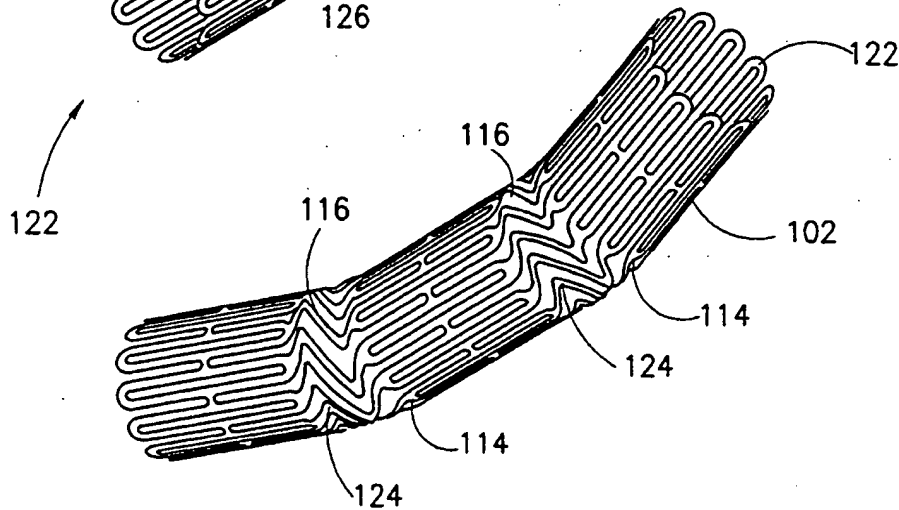


FIG. 3C

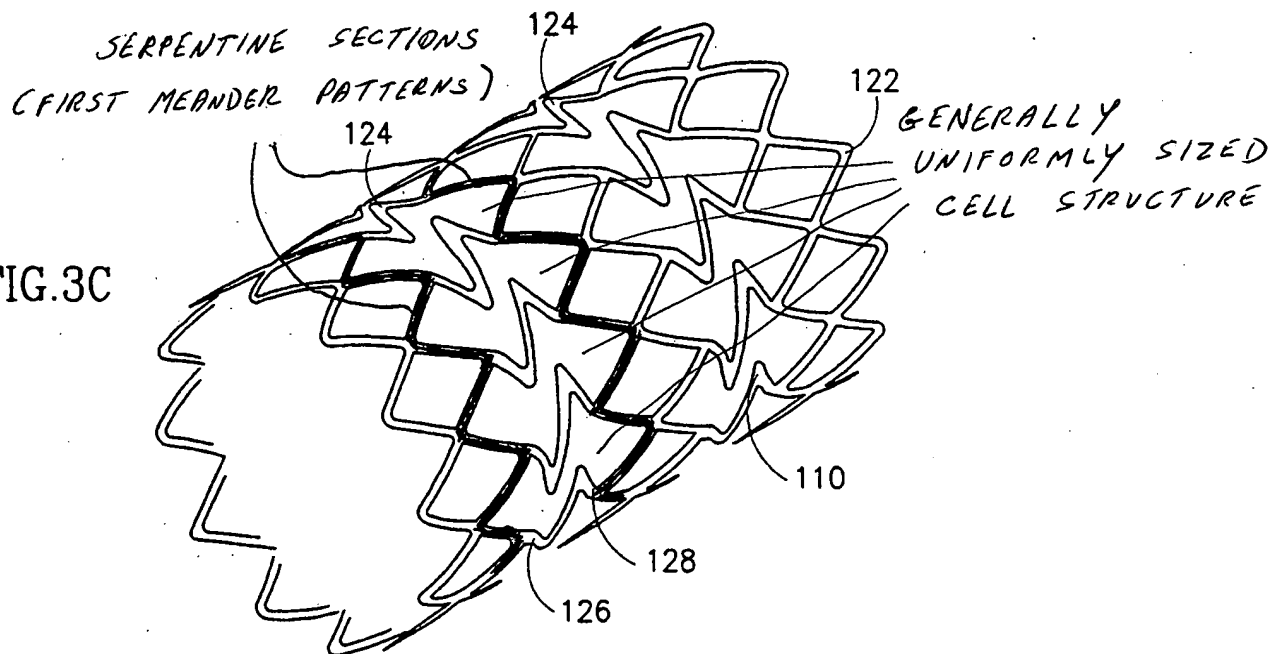


FIG. 3A

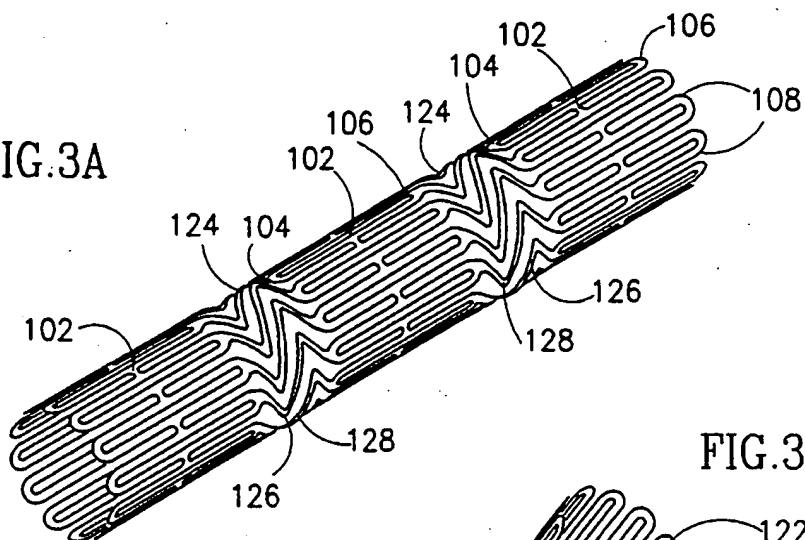


FIG. 3B

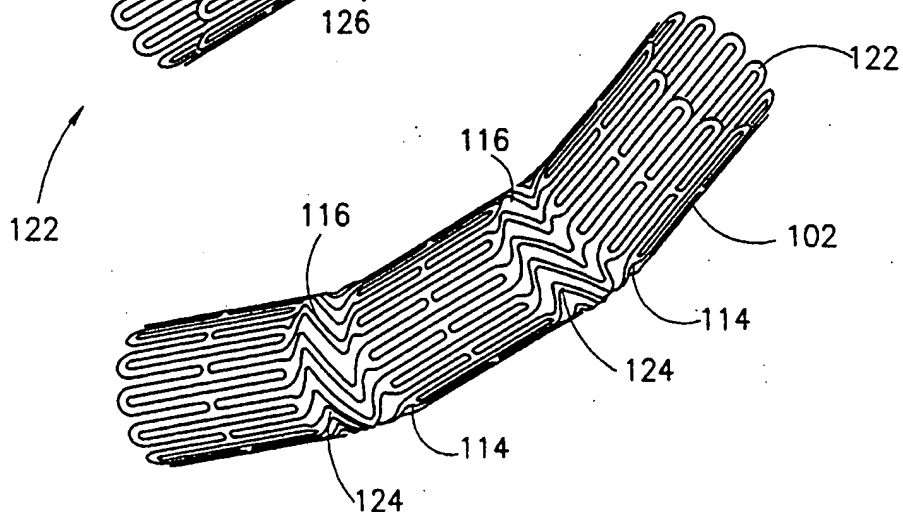


FIG. 3C

